

REMARKS

Claims 1 -14 are pending in the Application and are now presented for examination.

Claims 1-13 have been amended. Claim 14 has been added. No new matter has been added.

Claim 1 is the only independent claim.

Title Objection

On page 2 of the Office Action, the Title is objected to on the grounds that “the title of the invention is not descriptive.” The Title, as amended, now recites “RESPIRATOR HAVING AN INTEGRATED ORONASAL MASK.” Accordingly, the objection is believed to have been overcome and Applicants respectfully request the withdrawal of the objection.

Abstract Objection

On page 2 of the Office Action, the Abstract is objected to on the grounds that “the word ‘comprising’ should be avoided.” The Abstract has been amended to remove the word “comprising.” The abstract has been further amended for the sake of clarity. As such, the objection is believed to have been overcome and Applicants respectfully request the withdrawal of the objection.

Patentability Under 35 U.S.C. § 112, Second Paragraph

On page 3 of the Office Action, Claims 1-13 are rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim

the subject matter which applicant regards as the invention. Applicants respectfully traverse the rejection.

Claims 1-13 have been amended to overcome the 35 U.S.C. § 112, second paragraph rejection. Applicants believe these amendments have overcome the rejection, and respectfully request the withdrawal of the rejection.

Of the rejections to Claims 1-13, Claims 2, 5, 7, 9-11 and 13 were rejected as being based on rejected independent Claim 1. As the 35 U.S.C. § 112 rejection to Claim 1 is believed to have been overcome, Applicants respectfully request the withdrawal of the rejection to Claims 2, 5, 7, 9-11 and 13.

Patentability Under 35 U.S.C. § 103

Claims 1-14

The claims relate to a respirator including an outer mask defining a first volume. An oronasal mask that defines a second volume. The oronasal mask is positioned within the first volume. A primary filter is fixed to the outer mask and a secondary filter is positioned within the first volume such that the secondary filter filters air traveling from the first volume to the second volume. The secondary filter filters air traveling around a portion of the second volume. The filters filtering either particles or vapors, or a mixture of these, as required.

Claims 1-3, 8, 9 and 11-13

On page 4 of the Office Action, Claims 1-3, 8, 9 and 11-13 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Richardson *et al.* (U.S. Patent #: 7,013,891 B2,

hereinafter referred to as “Richardson”) and in view of Tayebi (U.S. Patent No: 4,945,907 A1, hereinafter referred to as “Tayebi”). Applicants respectfully traverse the rejection.

The Office Action uses impermissible hindsight to modify Richardson with Tayebi

“The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness” (M.P.E.P. § 2142). “Obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so” (M.P.E.P. § 2143.01). However, “any judgment of obviousness” cannot include “knowledge gleaned only from applicant’s disclosure” (M.P.E.P. § 2145). The Office Action does just that by using knowledge gleaned only from Applicants’ disclosure as a roadmap for modifying Richardson with Tayebi (M.P.E.P. § 2145).

For example, page 4 of the Office Action uses “knowledge gleaned only from applicant’s disclosure” to modify Richardson in order to incorporate Tayebi’s external filter liner 18. Specifically, the Office Action adds Tayebi’s *external* filter liner 18 into Richardson’s *internal conduit* (emphasis added). Moreover, Tayebi’s external filter liner 18 appears to be same element as Richardson’s filter canister 7, *both* of which are *externally* located (Tayebi: col. 9, lines 29-31; Richardson: FIG. 4). There is simply no reason to incorporate Tayebi’s external filter liner 18, internally, into Richardson’s respirator, absent “knowledge gleaned from applicant’s disclosure” (M.P.E.P. § 2145). As such, the Office Action is inappropriately using impermissible hindsight to combine Richardson and Tayebi in order to incorporate Tayebi’s external filter 18, internally, into Richardson’s Respirator. As such, Applicants respectfully request the rejection be withdrawn.

Moreover, as discussed above, “any judgment of obviousness” cannot include “knowledge gleaned only from applicant’s disclosure” (M.P.E.P. § 2145). However, the Office Action improperly uses “knowledge gleaned only from applicant’s disclosure” to make the rejection. In particular, the Office Action adds Tayebi’s external filter liner 18, internally, *between ocular mask 50 and oronasal mask 2* as opposed to externally as described by Tayebi (col. 9, lines 29-31; col. 12, lines 23-25)(emphasis added). There is simply no motivation for placing Tayebi’s external filter liner 18 between the specific elements in Richardson’s respirator, absent using “knowledge gleaned only from applicant’s disclosure” (M.P.E.P. § 2145). As such, the Office Action is inappropriately using impermissible hindsight to combine Richardson and Tayebi in order to specifically place Tayebi’s external filter liner 18 into a specific internal location in Richardson’s respirator, and Applicants respectfully request the rejection be withdrawn.

Accordingly, the Office Action uses impermissible hindsight to combine Richardson and Tayebi, and Applicants respectfully request the withdrawal of the rejection. Even assuming that impermissible hindsight was used in rejecting Applicants’ claims, Applicants respectfully assert that cited references do not teach or suggest Applicants’ claimed invention.

Amended Independent Claim 1

Amended independent Claim 1 recites, in part, “an oronasal mask defining a second volume, the oronasal mask is positioned within the first volume.” Richardson and Tayebi, whether considered individually or in combination, fail to disclose these features.

Page 4 of the Office Action relies on Richardson's oronasal mask and air ducts as allegedly disclosing "an oronasal mask defining a second volume, the oronasal mask is positioned within the first volume." Richardson fails does not disclose these features.

In particular, pages 4-5 of the Office Action interprets Richardson's oronasal mask as allegedly disclosing the claimed second volume and a portion of Richardson's ducts as allegedly disclosing the claimed first volume. Richardson does not. Richardson's oronasal mask is not located within the ducts as would be required by the Office Action's interpretation of the claimed first and second volumes (See page 5 of Office Action- marked up FIG. 4). As such, Richardson fails to disclose or suggest the features of Claim 1.

Tayebi fails to cure the deficiencies of Richardson. The Office Action does not cite Tayebi as disclosing or suggesting these features of amended Claim 1. Applicants agree Tayebi fails to disclose or suggest these features. Claim 1 is patentable for at least this reason.

Moreover, amended independent Claim 1 recites, in part, "a secondary filter positioned within the first volume, the secondary filter filtering air traveling from the first volume to the second volume." Neither Richardson nor Tayebi, whether considered individually or in combination, disclose or suggest these features.

Page 4 of the Office Action states "Richardson...lacks a secondary filter." Applicants agree Richardson fails to disclose these features.

Page 4 of the Office Action relies on Tayebi's external filter liner 18 as allegedly disclosing "a secondary filter positioned within the first volume, the secondary filter filtering air traveling from the first volume to the second volume." Tayebi does not disclose these features. Tayebi merely describes "a face mask 10 with an *external* filter liner 18 mounted thereon", i.e.,

filter line 18 may be “removably attached to the outside of mask shell 11 by a retainer arrangement” (col. 9, lines 29-31; col. 38-42)(emphasis added). Tayebi’s external filter liner 18 is simply not positioned within the first volume, let alone for “filtering air traveling from the first volume to the second volume.

At most, Tayebi describes an internal filter liner 17 to treat breathed air. For example, filter line 17 is used in a sandwich configuration with filter liner 18 to filter breathed air (FIG. 7), i.e., is configured similar to filter liner 18. Tayebi’s internal filter liner 17 does not filter “air traveling from the first volume to the second volume” as claimed. As such, Tayebi fails to disclose or suggest the features of Claim 1.

Accordingly, Richardson and Tayebi, whether considered individually or in combination, fail to disclose or suggest the features of Claim 1, and Applicants respectfully request the withdrawal of the rejection.

Dependent Claims 2-3, 8, 9 and 11-13

Claims 2-3, 8, 9 and 11-13 are each dependent either directly or indirectly from one or another of independent Claim 1, discussed above. These claims recite additional limitations which, in conformity with the features of independent Claim 1, are not disclosed or suggested by the art of record. The dependent claims are therefore believed patentable. However, the individual reconsideration of the patentability of each claim on its own merits is respectfully requested.

Dependent Claim 2

In addition to being patentable by virtue of its dependency from an independent claim believed to be allowable, Claim 2 is believed to be patentable on its own merits. Claim 2 recites,

in part, “the secondary filter filters air traveling **around** a portion of the second volume” (emphasis added). Richardson and Tayebi, whether considered in individually or in combination, fail to disclose or suggest these features.

As discussed above with respect to Claim 1, Richardson does not disclose or suggest a “secondary filter.” Richardson also does not disclose or suggest “air traveling around a portion of the second volume.” At most Richardson describes one channel through which air is passed from filter 7 to oronasal mask (FIG. 4). In particular, Richardson’s respirator configuration requires all air, passing through the single air channel, to pass through every element along the air channel, i.e., not around a portion of the second volume as claimed. As such, Richardson fails to disclose or suggest the features of Claim 2.

Tayebi fails to cure the deficiencies of Richardson. As discussed above with respect to Claim 1, Tayebi merely describes an external filter liner 18 and internal filter liner 17 that are located at the front of mask 10. In particular, air passes from external filter liner 18 to internal filter liner 17, then to the interior of mask 10 (FIG. 5). That’s it. Absent from Tayebi is any discussion of any filter filtering “air traveling around a portion of the second volume” as claimed. As such, Tayebi fails to disclose or suggest these features.

Accordingly, Richardson and Tayebi, whether considered individually or in combination, fail to disclose or suggest the features of Claim 2, and Applicants respectfully assert Claim 2 is allowable for at least this reason.

Dependent Claim 13

In addition to being patentable by virtue of its dependency from an independent claim believed to be allowable, Claim 13 is believed to be patentable on its own merits. Claim 13

recites, in part, “the oronasal mask is arranged to form a seal against a wearer’s face such that **the secondary volume forms a separate self contained volume within the first volume**” (emphasis added). Richardson and Tayebi, whether considered individually or in combination, fail to disclose or suggest these features.

Pages 5 and 7 of the Office Action rely on Richardson’s FIG. 4 as allegedly disclosing that “the secondary volume forms a separate self contained volume within the first volume.” Richardson does not. Richardson, as interpreted by the Office Action on Page 5, describes air that is free to flow from inlet 5 to oronasal mask 2. In particular, “[a]ir is inhaled through the respirator air inlet 5 into the interior 51 of the ocular mask 50 via the ocular mask air inlet 52, then through the ocular mask air outlet 53 into the interior 6 of the inner mask,” i.e., the alleged secondary volume is *not* a separate self contained volume (col. 7, lines 25-28)(emphasis added). As such, Richardson fails to disclose or suggest the features of Claim 1.

Tayebi fails to cure the deficiencies of Richardson. Tayebi, as described above with respect to Claim 1, merely describes a face mask with an external filter liner 18 and internal filter liner 17 that may be replaced by a filter cartridge. Tayebi’s face mask with filter liners simply do not disclose “the secondary volume forming a separate self contained volume within the first volume” as recited in Claim 13. As such, Tayebi fails to disclose or suggest the features of Claim 13.

Accordingly, Richardson and Tayebi, whether considered individually or in combination, fail to disclose or suggest the features of Claim 13, and Applicants respectfully request the withdrawal of the rejection.

Dependent Claims 4 and 5

On page 7 of the Office Action, Claims 4 and 5 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Richardson in view of Tayebi in further in view of Keifer et al. (U.S. Patent #: 7,261,104 B2, hereinafter referred to as “Keifer”). Applicants respectfully traverse the rejection.

Claims 4 and 5 depend from Claim 1. As explained above, Richardson and Tayebi fail to teach or suggest at least one element of Claim 1. Keifer fails to teach or suggest the elements of Claim 1 not disclosed or suggested by Richardson and Tayebi. For example, Keifer fails to teach or suggest “a secondary filter positioned within the first volume, the secondary filter filtering air traveling from the first volume to the second volume.”

In contrast to Claim 1, Keifer describes a first embodiment (10) that includes inhalation ports 110 each having filtering element connectors 400 (FIGS. 1A, and 1C, col. 5, lines 17-35). Keifer also describes a second embodiment (10') in which an inhalation port 274 cooperates with filtering cartridge 800 (FIG. 2C). There is simply no “secondary filter filtering air traveling from the first volume to the second volume” as claimed. Thus, each filter element in Keifer (400) operates as a primary filter that receives and filters outside air before the air passes into the mask. Thus, Keifer fails to teach or suggest “the secondary filter is provided to filter gas passing from the main volume to the secondary volume” as recited in Claim 1.

Therefore, Richardson, Tayebi and Keifer, whether considered individually or in combination, fail to teach or suggest at least one element of Claim 1, from which Claims 4 and 5 depend. Hence, Claims 4 and 5 are allowable, at least by virtue of their dependency from an allowable Claim.

Dependent Claims 6 and 7

On page 8 of the Office Action, Claims 6 and 7 were rejected under 35 U.S.C. §103(a) as purportedly being unpatentable over Richardson in view of Tayebi in further in view of Bee (U.S. Patent #: 7,089,931 B2, hereinafter referred to as “Bee”). Applicants respectfully traverse the rejection.

Claims 6 and 7 depend from Claim 1. As explained above, Richardson and Tayebi fail to teach or suggest at least one element of Claim 1. Bee fails to teach or suggest the elements of Claim 1 not disclosed or suggested by Richardson and Tayebi. For example, Bee fails to teach or suggest “a secondary filter positioned within the first volume, the secondary filter filtering air traveling from the first volume to the second volume.” In contrast to Claim 1, Bee describes a respirator that allows inhaled air to be “drawn via ducts 8, 9 from the outside 7, and over the eyepiece of the ocular mask 2, before being drawn into the oronasal mask 3” (col. 3, lines 19-21). Bee’s respirator is not the same as “a secondary filter positioned within the first volume, the secondary filter filtering air traveling from the first volume to the second volume” as recited in Claim 1. Thus, Bee fails to teach or suggest “the secondary filter is provided to filter gas passing from the main volume to the secondary volume” as recited in Claim 1.

Therefore, Richardson, Tayebi and Bee, whether considered individually or in combination, fail to teach or suggest at least one element of Claim 1, from which Claims 6 and 7 depend. Hence, Claims 6 and 7 are allowable, at least by virtue of their dependency from an allowable claim.

New Dependent Claim 14

In addition to being patentable by virtue of its dependency from an independent claim believed to be allowable, Claim 14 is believed to be patentable on its own merits. Claim 14 recites, in part, “a visor positioned within the first volume such that air traveling around the secondary volume passes proximate the visor.” Richardson and Tayebi, whether considered individually or in combination, fail to disclose these features.

As discussed above with respect to Claim 2, Richardson and Tayebi fail to disclose “air traveling around the secondary volume.” It follows that Richardson and Tayebi also fail to disclose “a visor positioned within the first volume such that air traveling around the secondary volume passes proximate the visor” as claimed.

Accordingly, Richardson and Tayebi, whether considered individually or in combination, fail to disclose or suggest the features of Claim 14, and Applicants respectfully assert Claim 14 is allowable at least for this reason.

For all of the above reasons, the claim rejections are believed to have been overcome placing Claims 1-14 in condition for allowance, and reconsideration and allowance thereof is respectfully requested.

The Examiner is encouraged to telephone the undersigned to discuss any matter that would expedite allowance of the present application.

The Commissioner is hereby authorized to credit overpayments or charge payment of any additional fees associated with this communication to Deposit Account No: 502104.

Respectfully submitted,

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By: /Alan M. Weisberg/
Alan M. Weisberg
Reg. No: 43,982
Attorney for Applicant
Christopher & Weisberg, P.A.
200 East Las Olas Boulevard, Suite 2040
Fort Lauderdale, Florida 33301
Customer No: 70757
Tel: (954) 828-1488
Fax: (954) 828-9122
email: ptomail@cwiplaw.com

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